<u>REMARKS</u>

This Amendment is filed in response to the Notice of Non-Responsive Communication dated May 11, 2005, which has a reply period set to expire June 13, 2005.

<u>Non-Responsive Communication</u>

The Examiner states that the amendment filed on February 18, 2005 is non-responsive "because the newly added claims 18-25 disclose a new inventive concept different from the one previously submitted in claims 1-17." Without making comment as to the validity of the assertion of non-responsiveness, Claims 18-25 are cancelled to advance prosecution of the instant application. In addition, new Claims 26-32 are added.

Claim 26 recites:

> A method for using a computer running a computer-aided-design (CAD) tool to enforce a usage contract for the CAD tool, the method comprising:
> > entering a trigger condition from the usage contract into the computer; and
> > generating a payment request when a data file generated by the CAD tool satisfies the trigger condition.

Support for new Claim 26 is found in the Specification as originally filed, at least at page 4, lines 11-13, page 7, lines 17-19, and page 8, lines 2-8. No new matter is added.

Applicants respectfully submit that new Claim 26 discloses the same inventive concept as the claims previously submitted. Claim 26 recites "a method for **using a computer** ... **to enforce a usage contract** ... [by] generating a payment request when a data file generated by the CAD tool satisfies the trigger condition." (Emphasis added.) Claim 26 is therefore directed towards the same type of contractual control covered in original Claim 1. Claim 26 is simply focused on the computerized portions of the original claim to address the rejections of Claim 1 in the

previous Office Action under 35 U.S.C. 101 and 35 U.S.C. 102.

Claim 26 recites "generating a payment request when a data file generated by the CAD tool satisfies the trigger condition", and therefore is directed towards "produc[ing] a 'useful, concrete, and tangible result' ... [that] renders it statutory subject matter", as noted by the Federal Circuit in State Street Bank & Trust Co. v. Signature Financial Group, 149 F.3d 1368, 1375. Accordingly, Claim 26 is allowable under 35 U.S.C. 101. Claims 27-32 depend from Claim 18 and are therefore also allowable under 35 U.S.C. 101.

Claim 26 is further allowable under 35 U.S.C. 102(b) over PCT Patent Application PCT/F197/00685 from Philip Ginzboorg et al., published as International Publication No. WO 98/21676 on May 22, 1998 (hereinafter "Ginzboorg"). Ginzboorg does not teach or suggest "generating a payment request when a data file generated by the CAD tool satisfies the trigger condition" as recited in Claim 26. Rather, Ginzboorg teaches a system for "us[ing] centralized charging for billing multimedia services" (Ginzboorg, page 4, line 7) such as "Video-on-Demand service via the Internet" (Ginzboorg, page 7, lines 14-15). Thus, Ginzboorg does not relate to CAD tools, nor does Ginzboorg provide any impetus for determining whether "a data file generated by the CAD tool satisfies the trigger condition" as recited in Claim 26. Ginzboorg is directed towards distributing, rather than creating, content.

For at least this reason, Claim 26 is allowable over Ginzboorg under 35 U.S.C. 102(b). Claims 27-32 depend from Claim 26 and are therefore allowable under 35 U.S.C. 102(b) for at least the same reasons that Claim 26 is allowable. Accordingly, Applicants respectfully request consideration and allowance of new Claims 26-32.

Claim 27 recites, "wherein generating the payment request

comprises sending a payment to a vendor of the CAD tool as part of a transaction that generates the data file." Support for new Claim 27 is found in the Specification as originally filed at least at page 8, lines 2-8. No new matter is added. Ginzboorg does not teach or suggest any automated payment "as part of ... generat[ion of] the data file". Thus, for at least this additional reason, Claim 27 is further allowable under 35 U.S.C. 102(b) over Ginzboorg.

Claim 28 recites "wherein generating the payment request comprises disabling a set of features of the CAD tool." Support for new Claim 28 is found in the Specification as originally filed at least at page 8, lines 2-6. No new matter is added. As noted above, Ginzboorg does not involve any type of content creation, such as performed by a CAD tool, and certainly does not disclose or suggest "disabling a set of features of the CAD tool" as recited by Claim 28. Thus, for at least this additional reason, Claim 28 is further allowable under 35 U.S.C. 102(b) over Ginzboorg.

Claim 29 recites, "wherein generating the payment request comprises adding a watermark to the data file for identifying the data file as having been produced by the CAD tool," and Claim 30 recites, "wherein the watermark comprises at least one of non-functional data, a naming convention, a spacing convention, an ordering convention, and non-functional elements." Support for new Claims 29 and 30 is found in the Specification as originally filed at least at page 8, line 18 through page 9, line 7. No new matter is added. As noted above, Ginzboorg is directed towards providing, rather than generating, content, and therefore does not disclose or suggest watermarking. Thus, for at least this additional reason, Claims 29 and 30 are further allowable under 35 U.S.C. 102(b) over Ginzboorg.

Claim 31 recites, "wherein the CAD tool comprises an integrated circuit (IC) design tool," and Claim 32 recites:

> [W]herein the data file has a form of at least one of hardware description language (HDL), register transfer level description (RTL), a macro, a hard macro, a soft macro, a core, a hard core, a soft core, a net-list, a synthesizable net-list, a layout, a process-independent layout, and a process-dependent layout.

Support for new Claims 31 and 32 is found in the Specification as originally filed at least at page 6, line 10 through page 7, line 21. No new matter is added. Ginzboorg does not teach or suggest any type of content creation, and certainly does not disclose or suggest the IC-related design aspects recited in Claims 31 and 32. Thus, for at least this additional reason, Claim 31 and 32 are further allowable under 35 U.S.C. 102(b) over Ginzboorg.

CONCLUSION

Claims 26-32 are pending in the present Application. Allowance of these claims is respectfully requested.

If there are any questions, please telephone the undersigned at 408-451-5903 to expedite prosecution of this case.
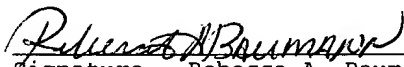
Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as FIRST CLASS MAIL in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on June 13, 2005, 2005.

6/13/2005
Date

Signature: Rebecca A. Baumann

8

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